

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application, and for the personal interview conducted on January 27, 2004, with the Examiner and his supervisor. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

The Examiner noted the requirements for sending IDS references. Applicant previously filed the appropriate references, and includes a copy of the return receipt postcard proving receipt by the Patent Office. Copies of the cited references are included with this amendment for the Examiners convenience.

The Examiner objected to the specification for lacking an abstract. An abstract has been provided with this amendment.

The Examiner requires applicant to amend the specification to include any essential material incorporated by reference. At this time, applicant's representative has not identified any essential material in any of the references requiring incorporation within the specification. However, applicant reserves the right to incorporate any material deemed essential while this application is pending and prior to issuance. Applicant's representative notes that nonessential subject matter may be incorporated by reference to (1) patents or applications published by the United States or foreign countries or regional patent offices, (2) prior filed, commonly owned U.S. applications, or (3) non-patent publications (MPEP §608.01(p)).

The Examiner objected to the specification for not including a "claiming" statement. The specification has been amended to state add such a statement, making the objection moot.

Claims 2-7 remain in this application. Claim 1 has been canceled. Claims 8-10 have been added without adding any new matter.

Claim 7 was rejected under 35 U.S.C. §112, second paragraph, for being indefinite for lacking antecedent basis. The claim has been amended to address this

issue, making the rejection moot.

Claims 1, 4 and 5 were rejected under 35 U.S.C. §102(b) as being anticipated by Ward (U.S. 4,811,402). Claims 2 and 3 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ward in view of Johnson (U.S. 4,311,206). Claim 7 was rejected under 35 U.S.C. §103(a) as being unpatentable over Ward in view of Saltykov (PCT WO 0038477). For the following reasons, the rejections are respectfully traversed.

Claim 1 has been canceled, and is replaced by new claim 8. Claim 8 recites a device having "a channel, at least a part of said outer surface of said device being formed by a one-part shell of said device defining an inner space, said channel being provided within and along said part of said shell and being formed within the material of said shell" Ward does not suggest such a channel.

Ward arguably suggests channels that traverse the interior of a hearing aid or an ear plug. However, Ward does not suggest a channel formed in a one-part shell that is part of an outer surface of the device, as recited in claim 1. In fact, it is clear from FIGs 2, 3, and 4, that any channel taught by Ward travels through an interior of its device, not through any one-part shell.

This distinction was pointed out to both the Examiner and his supervisor at the personal interview conducted in this case. Both the Examiner and the supervisor agreed that channel as defined by the new claim did not read on the Ward device. Although they indicated that an additional search might be conducted, it was clear from the discussion that the claim would overcome the Ward reference.

Accordingly, claim 8 is patentable over Ward. New claims 9 and 10 contain similar limitations to claim 8, and are thus patentable over Ward for at least the same reasons. The remaining claims in this case depend on one or more of claims 8, 9 and 10, and thus are patentable for at least the same reason as the parent claim.

Further, the Examiner has not provided the proper motivation for combining the references in the rejections of claims 2, 3, and 7. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion* or

motivation to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*).

Merely listing an advantage or benefit of the combination is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

"To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious at that time to that person." (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious "as a whole", not as a piecemeal combination of elements from various references.

Accordingly, the rejection for obviousness is not supported by the Office action and thus the rejection is improper, and should be withdrawn.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 32993.

Respectfully submitted,

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